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| 10/770,412 | 02/04/2004 | Ming Te Lai | BHT-3207-34 | 1926 |

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TROXELL LAW OFFICE PLLC
5205 LEESBURG PIKE, SUITE 1404
FALLS CHURCH, VA 22041

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| EXAMINER |
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DICUS, TAMRA

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| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,412

Applicant(s)

LAI, MING TE

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

The rejections under 35 U.S.C. 112, first and second paragraph, and objection to drawings are withdrawn due to Applicant's amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new claims 22 and 32 are not fully supported by the originally filled specification because the paper having a first surface area "substantially the same as a second surface area of said substrate" is considered new matter (pre-amended and originally filed specification denote a close size, not substantially the same). Applicant is reminded to point out in the specification any new limitations. See page 5, second paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially the same" is indefinite as the specification does not provide a definition to the metes and bounds of the phrase. In order to determine

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infringement of the present claims, one necessarily would need to determine with a reasonable degree of certainty the scope of the phrase "substantially the same." Applicant has failed to provide any such guidance and, accordingly, this phrase renders the scope of the claims unclear.

When a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph is proper. See *In re Wiggins*, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973). Additionally, a substantial portion was held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 19, 20, 22, 25-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 5,458,231 to Belokin et al.

Tamanini teaches a bag-packed decorative sticker set, comprising: a packing bag defining a receiving space (20, Fig. 1 and associated text), said packing bag including a sealed upper edge and an open lower edge, and flap downward extended from said open lower edge; said flap being normally folded upward to close an opening at said open lower edge and adapted to turn downward again expose said opening (see flap at top of 20); a substrate having a size suitable for positioning in said packing bag (22, Fig. 1 and associated text), and a front allowing an adhesive-applied surface to repeatedly detachably attached thereto (release 22 and adhesive stickers 26 thereon allow this to happen); and a set of individual decorative stickers together creating specific view (26, Figs. 1 and 2 and associated text), said decorative stickers being preliminarily detachably adhered at an adhesive-applied backside to the front of said substrate (26, 22, Figs. 1 and 2 and associated text), so as to be positioned into or removed from said packing bag along with said substrate (Fig. 1 and associated text). Tamanini teaches the substrate is a release paper which is opaque and thin. (Instant claims 19, 20, 30, and 31).

Tamanini teaches a card having information on it about the use (col. 6, lines 50-55) and attached to upper surfaces of what's shown (24, Fig. 1 and associated text, the sticker substrate is adjacent to the card, and this is interpreted as the upper surfaces of what's shown) (instant claims 4 and 14). Tamanini does not teach the size of the card and paper, however, the size of the card and substrate paper is an optimizable feature. It would have been obvious to produce a different

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size as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.

Tamanini does not teach an adhesive-applied flap or being adapted to hang on a display rack or rail (instant claims 19 and 30).

Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein (col. 2, lines 44-55) and being adapted to hang on a display rack or rail (col. 2, lines 55-61) so that the packaging goods inside may be suspended in a showcase or the like.

It would have been obvious to one having ordinary skill in the art to have modified the bag of Tamanini because Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein and being adapted to hang on a display rack or rail so that the packaging goods inside may be suspended in a showcase or the like (col. 2, lines 44-55 and col. 2, lines 55-61 of Yamagagta).

Tamanini does not teach the stickers are three-dimensional (3D).

However, Tamanini does teach the stickers have a symbol that may be chosen to suit the particular occasion or may be a mere pattern (col. 6, lines 35-48).

Belokin teaches 2D and 3D stickers to yield a different design such as a butterfly or holographic dinosaurs and the like displaying a dramatic exhibit (col. 1, lines 9-15 and col. 2, lines 30-33).

It would have been obvious to one having ordinary skill in the art to have modified the combination because Tamanini suggests stickers may have a generic pattern or design and Belokin teaches 2D and 3D removably attached stickers to yield a different design such as a

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butterfly or holographic dinosaurs and the like displaying a dramatic exhibit (col. 1, lines 9-15 and 42-44, and col. 2, lines 30-33).

To the various designs of the stickers including costumes, animals, beads, flowering plants, women's personal items of instant claims 7-12 and 17, it would have been obvious to one having ordinary skill in the art to have modified the combination to provide stickers any design due to the desired end use as Tamanini explains (col. 6, lines 35-48 of Tamanini).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 5,458,231 to Belokin et al. and further in view of USPN 5,989,667 to Tayebi.

Tamanini teaches the substrate is a release paper, but does not teach a transparent substrate (instant claim 21).

Tayebi teaches a sticker of paper or transparent film (thin) (col. 4, line 30-41) as an equivalent support.

It would have been obvious to one having ordinary skill in the art to have modified the combination to use a transparent thin sheet because Tayebi teaches a sticker of paper or transparent film (thin) as an equivalent support (col. 4, line 30-41 of Tayebi).

Claims 19, 20, and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 4,968,540 to Linsenbigler.

Tamanini teaches a bag-packed decorative sticker set, comprising: a packing bag defining a receiving space (20, Fig. 1 and associated text), said packing bag including a sealed upper edge and an open lower edge, and flap downward extended from said open lower edge; said flap being

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normally folded upward to close an opening at said open lower edge and adapted to turn downward again expose said opening (see flap at top of 20); a substrate having a size suitable for positioning in said packing bag (22, Fig. 1 and associated text), and a front allowing an adhesive-applied surface to repeatedly detachably attached thereto (release 22 and adhesive stickers 26 thereon allow this to happen); and a set of individual decorative stickers together creating specific view (26, Figs. 1 and 2 and associated text), said decorative stickers being preliminarily detachably adhered at an adhesive-applied backside to the front of said substrate (26, 22, Figs. 1 and 2 and associated text), so as to be positioned into or removed from said packing bag along with said substrate (Fig. 1 and associated text). Tamanini teaches the substrate is a release paper which is opaque and thin. (Instant claims 19, 20, 30, and 31).

Tamanini teaches a card having information on it about the use (col. 6, lines 50-55) and attached to upper surfaces of what's shown (24, Fig. 1 and associated text, the sticker substrate is adjacent to the card, and this is interpreted as the upper surfaces of what's shown) (instant claims 4 and 14). Tamanini does not teach the size of the card and paper, however, the size of the card and substrate paper is an optimizable feature. It would have been obvious to produce a different size as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.

Tamanini does not teach an adhesive-applied flap or being adapted to hang on a display rack or rail (instant claims 19 and 30).

Yamagata teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein (col. 2, lines 44-55) and

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being adapted to hang on a display rack or rail (col. 2, lines 55-61) so that the packaging goods inside may be suspended in a showcase or the like.

It would have been obvious to one having ordinary skill in the art to have modified the bag of Tamanini because Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein and being adapted to hang on a display rack or rail so that the packaging goods inside may be suspended in a showcase or the like (col. 2, lines 44-55 and col. 2, lines 55-61 of Yamagagta).

Tamanini does not teach the stickers are three-dimensional (3D) (instant claims 19 and 30) nor that the stickers are formed by curling paper of a predetermined width (instant claims 23-24 and 33-34).

However, Tamanini does teach the stickers have a symbol that may be chosen to suit the particular occasion or may be a mere pattern (col. 6, lines 35-48).

Linsenbigler teaches a 3D sticker such as a bow having curled paper of predetermined widths and overlapping fashion (instant claims 23-24 and 33-34) (Fig. 3 and col. 4, lines 25-68).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include three-dimensional (3D) stickers that are formed by curling paper of a predetermined width because Linsenbigler teaches a 3D sticker such as a bow having curled paper of predetermined widths and overlapping fashion as a design used in packages, envelopes and greeting cards (Fig. 3, col. 3, lines 40-46, and col. 4, lines 25-68 of Linsenbigler).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 4,968,540 to Linsenbigler and further in view of USPN 5,989,667 to Tayebi.

Tamanini teaches the substrate is a release paper, but does not teach a transparent substrate (instant claim 21).

Tayebi teaches a sticker of paper or transparent film (thin) (col. 4, line 30-41) as an equivalent support.

It would have been obvious to one having ordinary skill in the art to have modified the combination to use a transparent thin sheet because Tayebi teaches a sticker of paper or transparent film (thin) as an equivalent support (col. 4, line 30-41 of Tayebi).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 4,89,265 to Ueda et al.

Tamanini teaches a bag-packed decorative sticker set, comprising: a packing bag defining a receiving space (20, Fig. 1 and associated text), said packing bag including a sealed upper edge and an open lower edge, and flap downward extended from said open lower edge; said flap being normally folded upward to close an opening at said open lower edge and adapted to turn downward again expose said opening (see flap at top of 20); a substrate having a size suitable for positioning in said packing bag (22, Fig. 1 and associated text), and a front allowing an adhesive-applied surface to repeatedly detachably attached thereto (release 22 and adhesive stickers 26 thereon allow this to happen); and a set of individual decorative stickers together creating specific view (26, Figs. 1 and 2 and associated text), said decorative stickers being preliminarily detachably adhered at an adhesive-applied backside to the front of said substrate (26, 22, Figs. 1 and 2 and associated text), so as to be positioned into or removed from said packing bag along

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with said substrate (Fig. 1 and associated text). Tamanini teaches the substrate is a release paper which is opaque and thin. (Instant claims 19, 20, 30, and 31).

Tamanini teaches a card having information on it about the use (col. 6, lines 50-55) and attached to upper surfaces of what's shown (24, Fig. 1 and associated text, the sticker substrate is adjacent to the card, and this is interpreted as the upper surfaces of what's shown) (instant claims 4 and 14). Tamanini does not teach the size of the card and paper, however, the size of the card and substrate paper is an optimizable feature. It would have been obvious to produce a different size as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.

Tamanini does not teach an adhesive-applied flap or being adapted to hang on a display rack or rail (instant claims 19 and 30).

Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein (col. 2, lines 44-55) and being adapted to hang on a display rack or rail (col. 2, lines 55-61) so that the packaging goods inside may be suspended in a showcase or the like.

It would have been obvious to one having ordinary skill in the art to have modified the bag of Tamanini because Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein and being adapted to hang on a display rack or rail so that the packaging goods inside may be suspended in a showcase or the like (col. 2, lines 44-55 and col. 2, lines 55-61 of Yamagagta).

Tamanini does not teach the stickers are formed by different stacked and overlapped planar parts together to form a scene with visual depth.

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Ueda teaches a multilayered reflective adhesive sheet comprising reflective bead layers, adhesives, and films (planar parts) and used for stickers producing an ornamental effect having reflecting properties (together form a scene with visual depth, col. 4, lines 1-18 and FIG. 1 and associated text).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include three-dimensional (3D) stickers that are formed by different stacked and overlapped planar parts together to form a scene with visual depth because Ueda teaches a multilayered reflective adhesive sheet comprising reflective bead layers, adhesives, and films used for stickers producing an ornamental effect having reflecting properties (col. 4, lines 1-18 and FIG. 1 and associated text of Ueda).

Response to Arguments

Applicant's arguments filed 05-22-06 have been fully considered but they are not persuasive.

Applicant argues the references individually instead of as a combination. The Examiner will address the arguments as a 103 obviousness rejection and not a 102 as set forth below. The motivation for each reference is reiterated above.

Applicant argues the prefold is not taught by the prior art reference Yamagata, but is rather folded along the cut line after the package is filled. Applicant has not persuasively argued because the flap of the instant invention is intended to be folded over and the process limitations of pre/post folding are obvious as the flap of the prior art is folded over and thus serve no patentable significance between folding vs. prefolded flaps.

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Applicant argues Belokin does not teach 3D stickers having a specific view like a fairy tale or the like. However, Belokin was used to teach 2D and 3D stickers to yield a different design such as a butterfly or holographic dinosaurs and the like displaying a dramatic exhibit (col. 1, lines 9-15 and col. 2, lines 30-33). Further, Tamanini explicitly teaches stickers have a symbol that may be chosen to suit the particular occasion or may be a mere pattern (col. 6, lines 35-48). Therefore, it is an obvious design dependent upon the desired end use.

Applicant argues Lisenbigler, alleging a bow with a peel-off sheet is not a 3D sticker . The Applicant has not provided a persuasive argument because a sticker is merely an decorative sheet with adhesive on the back, which is indeed what Lisenbigler teaches.

Tayebi is still used to teach a sticker of paper or transparent film (col. 4, line 30-41) as an equivalent support.

Ueda is now used to teach the new claim 36 to the stacked parts as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

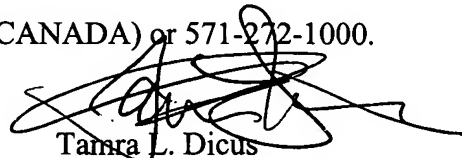
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

July 26, 2006



**B. HAMILTON HESS
PRIMARY EXAMINER**